

## REMARKS/ARGUMENTS

These Remarks are responsive to the Office Action mailed October 18, 2006 ("Office Action"). Applicants respectfully request reconsideration of the rejections of 1-39 for at least the following reasons.

### **Claim Rejections under 35 U.S.C. § 102**

Claims 1, 5-8, 10, 13, 15, 19-22, 24, 27, 29 and 33-38 are currently rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,559,496 to Dubats ("Dubats"). The Office Action alleges that Dubats teaches the claimed inventions. For at least the reasons detailed below, Applicants respectfully disagree.

As stated in Dubats, the "remote patrol system (RPS)" consists of two physical groups: a base station and one or more remote monitors. Col. 1, lines 39-40. The remote monitor consists of: one or more object sensors, a data log, connecting cables, and a data transceiver. Col. 1, lines 44-45. A base station consists of: a transceiver, a microprocessor-based data processor unit computer, data conversion devices, software code instructions, one or more form of data storage devices, user interface devices, and output devices, all collectively referred to as a computer. Col. 2, lines 20-24.

The data log component of the remote monitor is disclosed as storing "event/date information for subsequent transmission to the base station through a communication link." Col. 2, lines 4-6. The base station computer is disclosed as interpreting "event and date information received from monitored areas ...[i]nterpretation and analysis may consist of merely recording time and duration of intrusion, or may include estimates of speed, size, direction and identifying and classifying the probable nature of each intrusion event with summary words or phrases such

as “pedestrian,” “automobile,” and “truck” and/or icon figures to represent the inferred nature of the object.” Col. 2, lines 29-38.

Thus, as disclosed Dubats’ disclosed RPS system includes a passive monitoring site that records events and transmits them to a base station where the events are interpreted. Further, Dubats does not use satellite signals to activate a local alarm/warning system at the subscriber location. Instead, Dubats monitors data at the remote site and transmits the monitored data to the base station which then processing the data to determine an event. Missing from Dubats is any disclosure that allows the passive monitoring site to receive satellite signals from the base station wherein satellite signals carry data to activate a local alarm/warning system at the passive monitoring site. This claim limitation is completely missing from Dubats as Dubats is limited to a passive monitoring site that merely sends data to the base station for any and all processing.

For the claim limitation directed to satellite signals that “carry data to activate an alarm/warning system at the subscriber location,” the Office Action relies on Dubats disclosure at column 9, lines 47-55. However, upon close examination of this passage, Dubats refers to selecting a remote icon to “make that monitored site active.” In other words, the base station can determine which sites are monitoring data and which sites are not monitoring data. *See also* col. 8, lines 36-43 and col. 10, lines 22-29. The passage relied upon by the Office Action does not refer to activating a local alarm/warning system at the subscriber location. Rather, any activation of Dubats refers to the ability to monitor data or not. In fact, as Dubats is directed to monitoring data at the remote sites, Dubats fails to provide any disclosure directed to an alarm/warning system.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. Anticipation requires that a prior art reference disclose, either

expressly or under the principles of inherency, each and every element of the claimed invention. In addition, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In this case, as discussed in detail above, the Office Action has failed to show that Dubats discloses each and every claim limitation recited by Applicants. For example, the claim limitations directed to “wherein satellite signals received at the subscriber antenna from the processing center carry data to activate a local alarm/warning system at the subscriber location” are not suggested or disclosed by Dubats. Therefore, the Office Action has failed to meet its burden. The rejection of claims 1, 5-8, 10, 13, 15, 19-22, 24, 27, 29 and 33-38 under 35 U.S.C. § 102(b) should be withdrawn and the claims allowed accordingly.

#### **Claim Rejections under 35 U.S.C. § 103**

Claims 2, 16 and 30 are currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dubats in view of U.S. Patent No. 6,658,463 to Dillon. Claims 3, 4, 17, 18, 31 and 32 are being allegedly unpatentable over Dubats in view of U.S. Patent No. 6,643,510 to Taylor. Claims 9 and 23 are being allegedly unpatentable over Dubats in view of U.S. Patent No. 6,764,261 to Stadler. Claims 11 and 25 are being allegedly unpatentable over Dubats in view of U.S. Patent No. 6,614,884 to Jang. Claims 12, 14, 26 and 28 are being allegedly unpatentable over Dubats in view of U.S. Patent No. 6,577,234 to Dohrmann.

As to claims 2, 16 and 30, the Office Action admits that Dubats fails to disclose “wherein the communicating means comprises a satellite return channel.” For this major deficiency, the Office Action relies upon Dillon’s satellite multicast proxy to teach the missing limitations. The Office Action summarily concludes that “it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device disclosed by Dubats according to the

teachings of Dillon to use a satellite return channel to accomplish the two -way communication.”  
*See* page 12, Office Action mailed October 18, 2006. Applicant respectfully disagrees. The motivation relied upon by the Office Action fails to consider how the system of Dubats could be reasonably modified based on the alleged teaching. The Office Action fails to provide a proper statement of motivation as to why one of ordinary skill in the art would modify Dubats that admittedly shows only one-way communication to accomplish two-way communication. The Dillon reference fails to teach the admitted deficiencies of Dubats. The Office Action’s statement of motivation is not based on any teaching but rather is a clear example of improper hindsight.

As to claims 3, 4, 17, 18, 31 and 32, the Office Action admits that Dubats fails to disclose “wherein the satellite signals are transmitted at a DBS frequency” and “wherein the satellite signals are transmitted at a FSS frequency.” For these major deficiencies, the Office Action relies upon Taylor’s mobile platform to teach the missing limitations. The Office Action summarily concludes that “it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device disclosed by Dubats according to the teachings of Taylor to set up the satellite signals to operate in the DBS frequency range.” *See* page 13, Office Action mailed October 18, 2006. In addition, The Office Action summarily concludes that “it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device disclosed by Dubats according to the teachings of Taylor to set up the satellite signals to operate in the FSS frequency range.” *See* page 13, Office Action mailed October 18, 2006. Applicant respectfully disagrees. The motivation relied upon by the Office Action fails to consider how the system of Dubats could be reasonably modified based on the alleged teaching.

The Office Action fails to provide a proper statement of motivation as to why one of ordinary skill in the art would modify Dubats to operate in a range that is not disclosed in Dubats, namely the DBS and FSS frequency range. The Taylor reference fails to teach the admitted deficiencies of Dubats. Further, there would be no motivation available to one of ordinary skill in the art at the time of the invention to combine the system of Dubats with Taylor, absent improper hindsight.

As to claims 9 and 23, the Office Action admits that Dubats fails to disclose “wherein the detection of the intruder interrupts the transmission of satellite signals.” For this major deficiency, the Office Action relies upon Stadler’s catch basin and manhole covers to teach the missing limitations. The Office Action summarily concludes that “it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device disclosed by Dubats according to the teachings of Stadler to alter the reporting mode so that detection of intrusion would stop the transmission of satellite signals.” See page 14, Office Action mailed October 18, 2006. Applicant respectfully disagrees. The motivation relied upon by the Office Action fails to consider how the system of Dubats could be reasonably modified based on the alleged teaching. The Office Action fails to provide a proper statement of motivation as to why one of ordinary skill in the art would modify Dubats to accommodate the alleged teachings of Stadler. The Stadler reference fails to teach the admitted deficiencies of Dubats. Further, there would be no motivation available to one of ordinary skill in the art at the time of the invention to combine the system of Dubats with Stadler, absent improper hindsight.

As to claims 11 and 25, the Office Action admits that Dubats fails to disclose “wherein the frequency of the satellite signals corresponds to a predetermined security condition.” For this

major deficiency, the Office Action relies upon Jang's automatic home alarm system and method to teach the missing limitations. The Office Action summarily concludes that "it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device disclosed by Dubats according to the teachings of Jang to assign each particular monitored area a particular frequency." See page 15, Office Action mailed October 18, 2006. Applicant respectfully disagrees. The motivation relied upon by the Office Action fails to consider how the system of Dubats could be reasonably modified based on the alleged teaching. The Office Action fails to provide a proper statement of motivation as to why one of ordinary skill in the art would modify Dubats that admittedly fails to show that the frequency of the satellite signals corresponds to a predetermined security condition. The Jang reference fails to teach the admitted deficiencies of Dubats. Further, there would be no motivation available to one of ordinary skill in the art at the time of the invention to combine the system of Dubats with Jang, absent improper hindsight.

As to claims 12, 14, 26 and 28, the Office Action admits that Dubats fails to disclose "selection means for selecting an active or inactive mode for the security system" and "means for providing local response to detection of the intruder." For these major deficiencies, the Office Action relies upon Dohrmann's security system to teach the missing limitations. The Office Action summarily concludes that "it would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the device disclosed by Dohrmann to include selection means to set the security system in an active or inactive mode." See pages 16-17, Office Action mailed October 18, 2006. Applicant respectfully disagrees. The motivation relied upon by the Office Action fails to consider how the system of Dubats could be reasonably modified based on the alleged teaching. The Office Action fails to provide a proper statement of motivation as to

why one of ordinary skill in the art would modify Dubats that admittedly fails to show that the active and inactive modes. In addition, the office Action fails to provide a proper statement of motivation as to why one of ordinary skill in the art would modify Dubats that admittedly fails to show a local response in the security system. The Dohrmann reference fails to teach the admitted deficiencies of Dubats. Further, there would be no motivation available to one of ordinary skill in the art at the time of the invention to combine the system of Dubats with Dohrmann, absent improper hindsight.

The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000). In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's sole justification for modifying Dubats has absolutely nothing to do with the deficiencies of Dubats. As admitted by the Office Action, Dubats fails to show the missing limitations as recited in claims 2-4, 9, 11, 12, 14, 16-18, 23, 25, 26, 28 and 30-32. The Office Action's statement of motivation fails to consider how Dubats could be modified by the teachings of the applied references. To properly modify Dubats to correct for these major deficiencies, the Office has the burden to show some motivation why providing those elements would have overcome some perceived problem with Dubats. Any such motivation is completely lacking. This is a clear example of improper hindsight.

The mere fact that Dubats can be modified does not render the resultant modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 ( Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *In re Hedges*, 783, F.2d 1038, 1041, 228 U.S.P.Q. 685, 687, (Fed. Cir. 1986), the U.S. Court of Appeals for the Federal Circuit stated that "the prior art as a whole must be considered. The teachings are to be viewed as they would have been viewed by one of ordinary skill." The court also stated that "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art'" (quoting *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA, 1965)).

Therefore, the proposed combinations fail to show, teach or make obvious the invention as claimed by Applicants. The Office Action has failed to provide proper motivation for modifying Dubats. Even if the Dubats reference could be combined with the alleged admitted prior art as suggested by the Office Action, the resulting combination would fail to disclose the combination of claimed limitations. Therefore, the Office Action has failed to meet its burden. The rejection of the claims 2-4, 9, 11, 12, 14, 16-18, 23, 25, 26, 28 and 30-32 under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed accordingly.



**CONCLUSION**


In view of the foregoing amendments and arguments, it is respectfully submitted that this application is in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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